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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: ROBINSON, ERIC
Application No.: 09/416,675
Date Filed: October 12, 1999
For: AUTOMATIC BACKUP SYSTEM

Appeal No. 2003-0744

Certificate of Mailing

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Dated: April 16, 2003

Maureen Vieira
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REPLY TO EXAMINER'S ANSWER

Sir:

The (10) *Grounds for Rejection* set forth in the Examiner's Answer are identical to the grounds of rejection set forth in the Final Office Action mailed on 10/02/01 and have been addressed in the Applicant's Brief on Appeal.

Applicant responds to points in the Examiner's (11) *Response to Argument* set forth in the Examiner's Answer that had not been raised earlier. All other issues raised in the (11) *Response to Argument* have been addressed in Applicant's Brief on Appeal. The description of the Claims and the Claims are set forth in Applicant's Brief.

Claim 21

The Examiner contends that Claim 21 does not exclude the use of a scheduler to perform an automatic backup (the Applicant contends that Makinen does not disclose the method of automatically backing up data from a computer as set forth in Claim 21 and that Makinen requires a scheduler for backup). The Examiner further contends that Claim 21 is

broad enough to read on the method of scheduled backup disclosed by Makinen (column 1, lines 55-62, and columns 2-4).

Claim 21 includes several steps. The third step requires that the computer recognize the ABS unit (Automatic Backup System unit) inserted into its PCMCIA port. The next step, the fourth step, requires that the computer launch its automatic backup procedure. The claim recites immediate automatic backup upon recognition of the ABS unit. The sequence of steps clearly excludes scheduling the automatic backup.

With respect to Makinen, Makinen explicitly teaches that a scheduler controls automated backup mechanism (column 1, lines 50-51 and lines 58-60). Over and over again, Makinen teaches that the automatic backup is scheduled and not automatically initiated upon the recognition of an ABS unit or any other unit for that matter in its PCMCIA port or any other port (see column 2, lines 16-17, lines 45-46; column 3, lines 7-9 and lines 21-25; and column 4, lines 37-42).

The bottom line is that Makinen never discloses or even suggests having an automatic backup that is not controlled or subject to a scheduler. The scheduler is a key element of the Makinen invention.

The Examiner contends that Applicant attacks the reference individually in the 103 rejection and that the combination of steps of Claim 21 clearly taught by Makinen and Harari.

Applicant does not attack the references or the combination. However, Applicant does attack the conclusion that the combination of the two references disclose all the steps of Claim 21 and the other claims of the application. Applicant, in its Brief, discloses what is taught by each reference individually to point out that neither teaches the automatic backup of Claim 21 and Applicant's other claims. Neither reference discloses initiating the automatic backup upon

recognition of the ABS unit. The combination of the two references does not remedy this deficiency. The combination does not teach the above sequence of the third and fourth steps.

The Examiner contends that the motivation to combine the teachings of Makinen and Harari was clearly stated in the Office Action. The Examiner continues that one of ordinary skill in the art presumably knows something about the art besides what it is explicitly disclosed by reference and knows how to apply the principles taught by the references to get the desired results. This is the crux of this appeal. As Applicant has pointed out in responses to the Office Actions and the Appeal Brief, the combination of the two references does not yield the process of Claim 21. The references failed to teach that the automatic backup procedure starts on recognition of the ABS unit in the PCMCIA port. The Examiner contends that it would be obvious to one ordinarily skilled in the art to apply the principles taught by the references to get the desired result. The desired result is what is set forth in Claim 21 and the other claims of the application. Nowhere is there a teaching, suggesting or disclosing Applicant's desired result. How can one ordinarily skilled in the art combine two teachings and modify the teachings to obtain a desired result when there is no teaching or suggestion of the desired result in the record? Only in hindsight can one combine the two references and make the necessary changes to obtain the method of Claim 21. Only in hindsight can one ordinarily skilled in the art reconstruct the combination of two references to yield Applicant's invention. Clearly, hindsight reconstruction is not a proper basis for rejecting a claim.

Claims 22-40

The Applicant argues that the Examiner used hindsight to arrive at the rejection of obvious for Claims 22-39 because no prior was cited to show the elements of these claims.

The Examiner's response to that argument was that the Examiner it took official notice that the steps set forth in these claims are well-known in the art.

As noted in Section 2144.04 of the Manual of Patent Examining Procedure, "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the Examiner's conclusion should be judicially applied. Furthermore, as noted by the court in *In re Ahlert* (424 F.2d 1088, 165 USPQ 418 (CCPA 1970)), any fact so noted should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriately to rely solely on common knowledge in the art without evidentiary support in the record as a principal evidence upon which a rejection was based (see *Zurko* 258 F.3d 1379 at 1386, 59 USPQ 2d 1693 at 1697; *Ahlert*, 424 F.2d 1088 at 1092, 165 USPQ 418, 421).

The Applicant in its Brief has already addressed the fact that there is no teaching or suggestion in the cited prior art for the elements set forth in Claims 22-39. The Examiner conveniently classifies all these elements as well-known in the art and relies on official notice to boot-strap support for this conclusion. The Examiner's reliance on official notice to supply the elements of Claims 21-39 is without support and misplaced. As stated by the CCPA in 1961, "The notice of facts beyond the record which may be taken by the Examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" (*In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420 citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). The recited elements of Claims 21-39 are beyond the record and are not capable of instant and unquestionable demonstration to defy dispute.

The Examiner argues that: "The references do not have to teach or suggest each step claimed by the Appellant. One of ordinary skill in the art presumably knows something about the art beyond that which is explicitly shown or suggested in the references and knows how to apply the principles taught in the combination of references to arrive at the desired result." Nowhere does the Examiner specify the "principles" taught in the combination of the references and the Examiner does not where there is any suggestion or disclosure in the prior art regarding the "desired result." As stated many times by the Applicant in the responses to the Office Actions and in the Brief, the combination of references does not read on the claims. The combination of the references requires a substantial change or addition to yield the claimed invention. A mere allegation that there is motivation to make the change does not meet the standard required. There must be a reason on the record to have one ordinarily skilled in the art motivated to make the change to obtain a desired result.

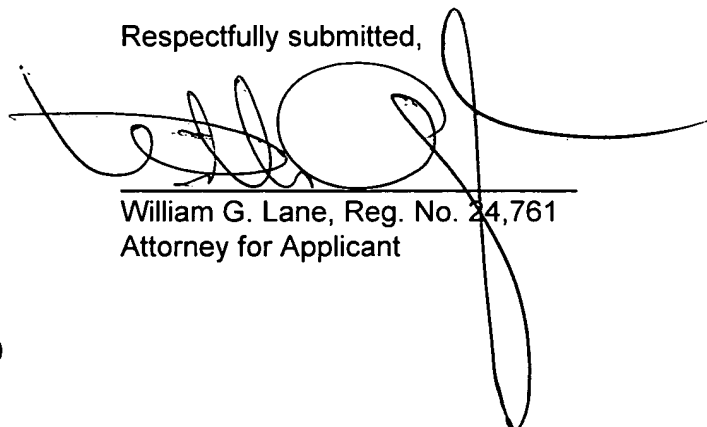
The Office Action is not supported by the record. Motivation requires a reason for doing an act. Somewhere in the prior art, there must be a suggestion or disclosure regarding the desirability of doing that act. Only then can one ordinarily skilled in art be motivated to carry out the act to obtain the desired result. The Examiner has failed to show the slightest teaching that an automatic backup system without a scheduler is a desired result. Without such a teaching, there is no motivation to alter the combination of the two references.

With respect to Claim 40, the Applicant argued in the Brief that the automatic backup taught by Makinen does not commence until the scheduled date and time programmed into the computer is met. The Examiner contends that Claim 40 does not exclude scheduled automatic backup, and that Claim 40 is broad enough to read on the scheduled automatic backup of Makinen. The Examiner contents that each reference does not have to teach the limitations of

Claim 40. That one of ordinary skill in the art having both Makinen and Harari references would certainly be motivated to combine the teachings as stated in the Office Action. The combination of Makinen and Harari does not yield the steps of Claim 40. The claim recites that: "The computer identifying the automatic backup device; the computer automatically launching a backup procedure to backup its files onto the automatic backup device...." In Claim 40, as Claim 21, recites that once the computer identifies the automatic backup device, the computer automatically launches a backup procedure and does not wait for a scheduled time or date. This claim does not read on an automatic procedure having a scheduler as taught in the prior art. The Examiner has failed to show why one ordinarily skilled in the art would eliminate a scheduler in backing up. No evidence has been introduced that such elimination is desired or beneficial. There is nothing in record to support the Examiner's unsupported allegations that one ordinarily skilled in the art would be motivated to make the necessary changes to the combination to yield the method of Claim 40.

In view of the above remarks and in light of the arguments set forth in Applicant's Brief, Applicant submits that Claims 21-40 are patentable over the cited prior art; that the 35 USC 103(a) rejection of the claims should be withdrawn and that the claims should be allowed.

Respectfully submitted,



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